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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,066	07/21/2003	Wes Johnson	1842-0018	5163

7590 07/07/2006

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EXAMINER	
SHAFFER, RICHARD R	

ART UNIT	PAPER NUMBER
3733	

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/624,066	JOHNSON ET AL.	
	Examiner	Art Unit	
	Richard R. Shaffer	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *117,118,121,125-129 and 201-218* is/are pending in the application.

4a) Of the above claim(s) *205-216* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *117,118,121,125-129,201-204,217 and 218* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 117, 118, 121, 125-129, and 204 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 39-71 of U.S. Patent No. 6,595,998. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the application and patent lies in the fact that the patent claims include many more elements and is thus more specific. Thus, the patent as claimed in 39-71 is in effect a "species" of the "generic" invention of claims 117, 118, 121, 125-129, and 204 in the current application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

It is understood that applicant intends to file a terminal disclaimer should the claims otherwise be allowable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 117, 118, 121, 125-129, 201-204, 217, and 218 are rejected under 35 U.S.C. 102(b) as being anticipated by Brantigan (US Patent 5,192,327).

Brantigan discloses an apparatus (**Figure 6**) comprising a plurality of wafers (**31**); they can be disposed atop one another (**Column 5, Lines 44-47**) in cooperative contact forming a structure intended for use between two vertebral bodies; the structure is expandable (*Definition by Merriam-Webster 10th Edition: to increase the extent, number, volume, or scope of*) if one so desired to add subsequent wafers atop another allowing the device to be capable of distraction (*Definition by Merriam-Webster 10th Edition: to draw or* ***direct to*** *a different object or in* ***different directions at the same time***) of the two vertebral bodies as well; each wafer interfaces with another via surfaces that are generally flat with complementary ridges (**22b**) and grooves (**22c**) to provide for constrained degrees (against the ridges as well as supporting the wafers vertically) of contact; and the wafers are capable of being inserted into the intervertebral space by moving the insertion tool sideways instead of forward/backward. The wafers of Brantigan is expandable by definition, it is inherently capable of distraction (should one

force them between two vertebral bodies), and they can be inserted one after another because insertion is not limited to positioning them atop each other in the direction of the bores (**13**). One could easily position the inserts atop one another by moving them sideways.

In regard to claims 217 and 218, Figure 7 and Figure 9 demonstrate tapered implants (thereby of different configurations because hole (13) would still have to be located in the same anatomical location on each.

In regard to claims 201-203, applicant broadly claims "**a** length" in each claim. Applicant fails to specify the length must be of the entire wafer so any portion defining "a length" would suffice. There are an infinite amount of possibilities for showing a length of one wafer being longer than a length of another.

Claims 117 and 201-203 are rejected under 35 U.S.C. 102(b) as being anticipated by Samani (US Patent 5,645,599).

Samani discloses a device (**Figure 4**) comprising a plurality of wafers (**1**) with additional wafers (**15**) configured for consecutive receipt, wherein the top wafer has a length (length of **5b**) larger than wafer (**15**), and the bottom wafer has a length (length **5b**) larger than wafer (**15**). Again, the device is expandable according the Merriam-Webster dictionary by increasing in number and is inherently capable of distraction of the intervertebral bodies when wafer (**15**) is inserted.

Response to Arguments

Applicant's arguments filed June 19th, 2006 have been fully considered but they are not persuasive. As explained in this current Office Action, Brantigan does disclose differently configured wafers through tapering (**Figures 7 and 9**). Further, as explained in the Office Action, the current language of claims 201-203 are overly broad and have been examined appropriately. In regard to Samani, again, "substantially" is a broad limitation. Merriam-Webster, 10th Edition defines substantially as being largely but not wholly that which is specified. It is clear that they are more alike than they are different.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richard Shaffer

Richard Shaffer
June 29th, 2006

EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER